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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/750,705

01/02/2004

Philip S. Siegel

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11/15/2006

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,705

Applicant(s)

SIEGEL, PHILIP S.

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006 and 12 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 10/12/2006 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/750,705 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Claim 4 has been cancelled; therefore Claims 1-3 and 5-23 are currently pending in application 10/750,705.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-3, 5-10, 13, 15, 16, and 18-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Drattell (US 2001/0032141 A1).**
5. As per **independent Claims 1, 20, and 22**, Drattell discloses a method (system, computer product) for processing returned items of merchandise (Abstract, outsourced return center),

comprising the steps of: providing returns guidelines to a local return agent over a communication link (Para 0022, central system link), the returns guidelines for use by the local return agent in making a determination at a location remote from a return center as to the eligibility of an item for return (Fig.3, Para 0022, central system provides TRC locations with high-level of intelligence to manage efficiently the returns for each retailer thus allowing TRC to ensure compliance with retailer's return policy – high-level intelligence equivalent to returns guidelines as used by TRC), the local return agent authorized to make the determination on behalf of a merchant (Para 0014, TRC contracts with e-retailers to process returns – contract is equivalent to official authorization to handle returns); receiving an item remotely determined to be eligible for return (Para 0017, determined by customer using retailer's published policies) at the return center (Para 0016); accessing one or more return rules of the merchant associated with the item (Para 0022, system provides retailer return policy information); and processing the return in accordance with the return rules (Para 0010, Para 0016, returns merchandise to retailer or manufacturer as directed).

6. As per Claim 2, Drattell discloses wherein the method is performed by a third party on behalf of the merchant (Para 0010, outsourced return center).
7. As per Claim 3, Drattell discloses wherein the method is performed for multiple merchants (Para 0019, e-retailers and catalog merchants).
8. As per Claim 5, Drattell discloses electronically delivering notice of the return to a merchant associated with the return (Para 0022, Claim 16, equivalent to issuing debit to retailer for return transaction).

9. As per Claim 6, Drattell discloses wherein the processing step is performed by determining a final destination of the return (Para 0016, returned per retailer or manufacturer directions).
10. As per Claim 7, Drattell discloses wherein the processing step is performed by determining disposition of the return (Claim 11, examining the returned merchandise).
11. As per Claims 8, 21, and 23, Drattell discloses wherein the accessing step is performed via the Internet (Para 0017, Internet).
12. As per Claim 9, Drattell discloses wherein the processing step is performed by returning an ineligible return to the customer (rejecting/returning the return is an inherent part of the system for those goods that don't meet retailers' policies, see Para 0022: compliance module).
13. As per Claim 10, Drattell discloses wherein the processing step is performed by shipping the item to a location maintained by a merchant associated with the item (Para 0010, Para 0016, return merchandise to retailer).
14. As per Claim 13, Drattell discloses labeling the item for subsequent processing (Para 0016, Returning/Reshipping to merchant or manufacturer would include labeling item for shipment).
15. As per Claim 15, Drattell discloses wherein the receiving step is performed by receiving the item directly from a customer (Para 0005, customer returns item to nearest location).
16. As per Claim 16, Drattell discloses inspecting the item at the returns center (Para 0010, Claim 11, examining the returned merchandise).
17. As per Claim 18, Drattell discloses crediting an account associated with a customer associated with the return (Para 0010, credit customers).

18. As per Claim 19, Drattell discloses accessing transaction data associated with the item (Para 0022, tracking information, purchase transaction).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 20. Claims 11, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drattell in view of Roman et al. (US 2002/0010634 A1).**

21. As per Claim 11, Drattell fails to disclose wherein the processing step is performed by assigning the item to an on-line auction.
22. However, Roman discloses a system for processing returns and disposing of the returns using an Internet auction web site (Para 0024).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included disposing of the collected product using an auction or Internet auction web site, as disclosed by Roman in the system disclosed by Drattell, for the advantage of providing a method (system) for enabling local return of remotely purchased products, with the ability to increase system cost effectiveness by offering several channels for disposing of the returned merchandise.

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24. As per Claim 12, Drattell fails to disclose wherein the processing step is performed by shipping the item to a re-purchaser.

25. However, Roman discloses a system for processing returns and disposing of the returns using an Internet auction web site (Para 0024), and then shipping the item to the “e-Buyer” (Para 0025, Phase 8 and 9).

26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the processing step is performed by shipping the item to a re-purchaser, as disclosed by Roman in the system disclosed by Drattell, for the advantage of providing a method (system) for enabling local return of remotely purchased products, with the ability to increase system cost effectiveness by offering several channels for disposing of the returned merchandise.

27. As per Claim 14, Drattell fails to expressly disclose wherein the receiving step is performed by receiving the item from a carrier.

28. However, Roman discloses a third-party system for processing returns, which receives the returns from the customer via a carrier (Para 0019-0020, US Postal Service).

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the receiving step is performed by receiving the item from a carrier, as disclosed by Roman in the system disclosed by Drattell, for the advantage of providing a method (system) for enabling local return of remotely purchased products, with the ability to increase system effectiveness and customer service by offering customers several channels for returning merchandise.

30. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Drattell in view of Schwab et al. (US 2002/0019777 A1).
31. As per Claim 17, Drattell fails to expressly disclose consolidating items to be shipped to a common destination.
32. However, Schwab discloses a third party returns processing system which bundles all returns dedicated to a specific merchant (Para 0050).
33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the processing step is performed by shipping the item to a re-purchaser, as disclosed by Schwab in the system disclosed by Drattell, for the advantage of providing a method (system) for enabling local return of remotely purchased products, with the ability to increase system cost effectiveness by consolidating shipments to like destinations.

Response to Arguments

34. Applicant's arguments filed 9/19/2006, regarding Claims 1-3 and 5-23, have been fully considered but not persuasive. The rejection will remain as NON-FINAL, based on the cited prior art.
35. The Applicant has made the argument that the cited prior art fails to expressly disclose providing returns guidelines to a local return agent over a communication link, the returns guidelines for use by the local return agent in making a determination at a location remote from a return center as to the eligibility of an item for return, the local return agent authorized to make the determination on behalf of a merchant.

36. However, as stated in the rejection above, Drattell discloses providing returns guidelines to a local return agent over a communication link (Para 0022, central system link), the returns guidelines for use by the local return agent in making a determination at a location remote from a return center as to the eligibility of an item for return (Fig.3, Para 0022, central system provides TRC locations with high-level of intelligence to manage efficiently the returns for each retailer thus allowing TRC to ensure compliance with retailer's return policy – high-level intelligence equivalent to returns guidelines as used by TRC), the local return agent authorized to make the determination on behalf of a merchant (Para 0014, TRC contracts with e-retailers to process returns – “contract” is equivalent to official authorization to process/handle returns).
37. In response to applicant's argument that there is no suggestion to combine the references (for rejection of claims 11, 12, and 14; Drattell in view of Roman), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Drattell and Roman disclose a system/method for outsourcing returns for retailers, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included disposing of the collected product using an auction or Internet auction web site, as disclosed by Roman in the system disclosed by Drattell, for the advantage of providing a method (system) for enabling local return of remotely purchased products, with

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the ability to increase system cost effectiveness by offering several channels for disposing of the returned merchandise.

Conclusion

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
40. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

November 7, 2006

JONATHAN OUELLETTE
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

